Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARS CROON and BERTIL ERIKSSON

Appeal No. 1998-1942
Application No. 08/530,254

ON BRIEF[1]

Before McCANDLISH, Senior Administrative Patent Judge, NASE and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

[1] On March 21, 2000, the appellants waived the oral hearing (see Paper No. 20) scheduled for April 5, 2000. We also note that the appellants have filed a request for refund (Paper No. 18, filed June 10, 1998) of the $135 oral hearing fee charged to their deposit account on January 5, 1998. The fee history records of the application does not indicate that the $135 check for the oral hearing (Check No. 17328) was ever processed. However, the fee history records of the application does indicate that the $135 oral hearing fee was credited back to the appellants deposit account on April 20, 1998. The examiner should ensure that all required fees in this application have been paid and that all excess fees have been refunded.

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DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 23-44, as amended subsequent to the final rejection.

These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a draining device for a hole in a floor with a floor covering (claims 23-40) and a method for draining a hole [sic, providing a drainage hole] in a floor having a floor covering (claims 41-44). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Whitsett	3,725,964	Apr. 10, 1973
Kessel	4,263,138	Apr. 21, 1981
Logsdon	4,742,585	May 10, 1988

Ermyr[2]	SE 332,787	Feb. 15, 1971
Braas[3]	DE 7,327,539	Nov. 15, 1973
Mallinen	WO 91/17324	Nov. 14, 1991

[2] In determining the teachings of Ermyr, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

[3] In determining the teachings of Braas, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Claim 41 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 23-26, 30-36 and 41-43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mallinen in view of Kessel and Ermyr.

Claims 27-29, 37 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mallinen in view of Kessel and Ermyr as applied to claims 23 and 25 above, and further in view of Braas.

Claims 39 and 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mallinen in view of Kessel and Ermyr as applied to claims 23 above, and further in view of Whitsett.

Claim 40 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mallinen in view of Kessel and Ermyr as applied to claims 23 above, and further in view of Logsdon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed October 17, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed September 2, 1997) and reply brief (Paper No. 16, filed December 16, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claim 41 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's reasons for rejecting method claim 41 as being indefinite are set forth on page 4 of the answer. In summary, the examiner believed that the scope of the claim was unclear due to the structural features recited therein. Specifically, the examiner determined that the claim was unclear as to the limitation imparted by the language "providing."

We agree with the appellants (Brief, p. 25) that the rejection as set forth by the examiner is contrary to USPTO practice since recitation of structure in a method claim is common. Moreover, in this instance, the claimed "providing"

steps are clear since they help to define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claim 41 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness rejections

We will not sustain the rejection of claims 23-44 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner's reasons for rejecting claims 23-44 under 35 U.S.C. § 103 are set forth on pages 5-7 of the answer. With respect to claims 23 and 41 (the independent claims on

appeal), the examiner believed that (1) Mallinen teaches all the claimed elements except for the space defining member being a gutter (trap); and (2) that it would have been obvious to one of ordinary skill in the art to modify Mallinen's space defining member to be a gutter (trap).

We agree with the appellants' argument (Brief, pp. 17-19) that the examiner's rejection of claims 23 and 41 is in error. Specifically, we see no reason from the teachings of the applied prior art for one of ordinary skill in the art to have modified Mallinen's space defining member to be a gutter (trap) absent the use of hindsight knowledge derived from the appellants' own disclosure.[4] That is, there is no motivation from the applied prior art for an artisan to have converted Mallinen's apparatus for preventing leakage water from flowing out of a mounting and casing tube into a draining device as set forth in claim 23.

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[4] The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Additionally, we agree with the appellants' argument (Brief, pp. 15-17) that certain features recited in the appellants' claims are not met when the prior art is combined as proposed by the examiner. The claimed depth dimension of the gutter member and the floor covering as it relates to the sealing means recited in claim 23 or the "preventing" step as recited in claim 41 are not met when the prior art is combined as proposed by the examiner.

For the reasons set forth above, the decision of the examiner to reject independent claims 23 and 41 and dependent claims 24-40 and 42-44 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 41 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 23-44 under 35 U.S.C.

§ 103 is reversed.

REVERSED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)

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